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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,743	01/19/2005	Jan Hall	21547-00302-US1	1919

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EXAMINER	
BUMGARNER, MELBA N	

ART UNIT	PAPER NUMBER
3732	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/521,743	HALL, JAN	
	Examiner	Art Unit	
	Melba Bumgarner	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-30* is/are pending in the application.

4a) Of the above claim(s) *26-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 26-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are related as process of use of the product. The product as claimed can be used in a materially different process such as having different space formation than the closed space, and parts in the jaw bone rather than the implant comprising inner and outer hole parts.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 21-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-28 of copending Application No. 10/520,759. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art as to the functional limitations of the implant with respect to the jaw bone hole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Recitation of "said hole" in claim 21 lacks sufficient antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gayer et al. (6,214,049). Gayer et al. disclose an implant for fitting into a bone hole having adjacent soft tissue 1004 and inner and outer hole parts 1002 with respective inner and outer hole diameters (figure 11) comprising an inner implant part 400 having an inner implant diameter, an outer

implant part 406 having an outer implant diameter, and GSS 404 disposed on a surface of the implant capable of interacting with bodily fluid, and a space is defined by the bone surface of the hole and the implant. Patentable weight is not given to the intended use of the implant with respect to a jaw bone hole and the hole is capable of receiving bodily fluids and GSS. The GSS is disposed on surface of the implant other than the outer surface of the implant. The GSS is disposed a two or more layers on an outer surface of the implant. The implant comprises bone substitute disposed adjacent to an implant part. The GSS is used for bone volume increase adjacent to the implant.

8. Claims 21, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Driskell (4,738,623). Driskell discloses an implant for fitting into a jaw bone hole 84 having adjacent soft tissue 18 and inner and outer hole parts with respective inner and outer hole diameters comprising an inner implant part 10 having an inner implant diameter, an outer implant part 26 having an outer implant diameter, and GSS 86 disposed on a surface of the implant capable of interacting with bodily fluid, the inner implant diameter is configured to be greater than the inner hole diameter, whereby the implant is configured to be anchored to the jaw bone upon fitting the inner implant part into the inner hole part, the outer implant diameter is configured to be lesser than the outer hole diameter, whereby a space is defined by the bone surface of the outer hole part, the outer implant part and the soft tissue configured to cover the outer implant part (figure 5). The implant comprises bone substitute disposed adjacent to an implant part. The GSS is used for bone volume increase adjacent to the implant.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Driskell in view of Pilliar et al. (5,344,457). Driskell discloses an implant that shows the limitations as described above; however, Driskell does not show GSS disposed on surface of the implant other than the outer surface. Pilliar et al. teach an implant having GSS disposed on the inner implant part 34. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implant of Driskell to have GSS disposed on the part as in Pilliar et al. in order to promote bone growth for anchoring part of the implant.

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Driskell. Driskell discloses an implant that shows the limitations as described above; however, Driskell does not show GSS disposed as two or more layers on the outer surface of the implant. It would have been an obvious matter of choice to one of ordinary skill in the art as to the GSS being disposed in layers. The layers are not disclosed as critical to the claimed invention and not shown in the figures.

Response to Arguments

12. Applicant's arguments with respect to claims 21-25 have been considered but are moot in view of the new ground(s) of rejection. As to the double patenting rejection, Applicant argues the

difference in the spatial relationship between the claimed implant and the bone to which it is to be implanted, but the claimed implants are not patentably distinct from each other.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melba Bumgarner

Melba Bumgarner
Primary Examiner